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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

JOHN C. PARKS, ET AL.

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EXAMINER: BADIO, B.

Attny. Docket No.: FR-6842-C
Customer No.: 2071

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313

Sir:

REPLY BRIEF

This brief is in reply to the Examiner's Answer ("Answer") dated April 30, 2004. This Reply Brief is submitted in triplicate.

The Answer indicates the Examiner remains unconvinced that the cited reference fails to establish a *prima facie* case to support the section 103(a) rejection. However, certain statements in the Answer suggest a misunderstanding of the standards which apply in establishing and challenging a *prima facie* case of obviousness under section 103.

In the "Response to Argument," the Examiner states, in the first paragraph on Page 5 of the Answer, the following:

> However, applicant has not provided any comparison of the prior art wet cake provided after treatment as taught by Mack and those of the claimed wet cake.
>
> (Emphasis added.)

In this sentence the Examiner seems to suggest that the Applicants have the burden of providing comparative data in rebuttal to the obviousness rejection. This is not the case, however, since the Applicants are asserting that the Examiner has not even made out a *prima facie* case of

obviousness. In other words, Applicants contend that there is no *prima facie* case of obviousness in view of the cited prior art, and that since there is no *prima facie* case to rebut, there is no need or requirement for rebuttal evidence.

The sole question on this appeal is whether the cited prior art reference, United States Patent 5,457,248 to Mack, establishes a *prima facie* case of obviousness sufficient to support the Examiner's rejection under section 103(a). Applicants contend that it does not, based upon a reasonable and fair reading of that reference as required by law.

In this regard, the Examiner cites only some of the relevant portions of the cited reference in the Answer. For instance, the Examiner states on Page 5 of the Answer, second full paragraph, the following:

> The examiner notes that the temperature at which the claimed product is dried is similar to the temperature at which the prior art product is oven-roasted, 205°C versus 200°C respectively.

Apparently the Examiner believes that, because Applicants' dried and ground product has a similar YI number to the oven-roasted end product of the prior art, the claimed wet cake and the prior art wet cake must have similar occluded free bromine content in parts per million. Yet, any such conclusion completely disregards the fact that the prior art reference also indicates that it *oven roasts* at 200°C for *30 minutes* (Mack, col. 12, line 12) before determining Yellowness Index, while the Applicants merely dried their wet cake at 205°C for *2 seconds* prior to determining Yellowness Index. (See Specification Example 1 at ¶ 64.) In other words, even if it were somehow reasonable to compare Applicants' dried wet cake to Mack's oven roasted end product (a truly apples-to-oranges comparison), Applicants dried their wet cake for a very small fraction (1/900ths) of the time employed by Mack, and this fact is nowhere acknowledged by the Examiner.

In addition, the Examiner appears to be using the teachings of the Applicants' own disclosure in attempting to make her case. For instance, on Page 5 of the Examiner's Answer, second full paragraph, the Examiner goes on to say:

> Based on the teachings of the prior art and the present disclosure, it is obvious that high temperatures, for example, roasting, are utilized in the removal of excess bromine and, thus, improvement in color characteristics of the brominated product.
>
> (Emphasis added.)

It is a basic principle of patent law that the Examiner may not rely upon the Applicants' disclosure of their invention to support a rejection of the claimed invention. See, e.g., MPEP § 2143, which notes:

> The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). (Emphasis added.)

Yet, the Examiner rests her conclusion on this house of cards, stating in the same paragraph on Page 5 of the Examiner's Answer:

> Therefore, the skilled artisan would have the reasonable expectation that applicant's dried product would have a lower bromine content and, thus, a lower YI value than the prior art product dried at 120°C.

Somehow, the Examiner appears to believe that the skilled artisan to which she refers, a construct under the law, could rely upon the Applicants' own teachings in arriving at that person's "reasonable expectations." As noted above, the law requires that those "reasonable expectations" be ascertained from the prior art *alone*, without the benefit of the Applicants' disclosure. Moreover, the Examiner completely disregards the fact that the samples from Examples 2-4 in Mack were further heat-treated through *roasting* at 200°C for *30 minutes* before the YI was determined.

In this same paragraph 5 of the Answer, the Examiner makes one last assertion which cannot go unaddressed. The Examiner states:

> In order to make a comparison between the two dried products, the drying temperatures should be similar and, thus, a better comparison would be between the claimed dried product having a YI of about 12.5 to about 17.5 and the oven-roasted prior art product with a YI of 14.8 to 16.1 since the temperature utilized for roasting of the prior art is similar to that utilized for drying by the present invention. (Emphasis added.)

Curiously, this passage reveals that the Examiner assumes that her *prima facie* case is made out, since it addresses the kind of comparative data the Examiner thinks is needed to rebut her rejection. She then supports her assertions regarding what the rebuttal evidence should be by relying on an incomplete recitation of the prior art disclosure. As noted earlier, the time employed to roast the prior art (*30 minutes*) is anything but similar to the time for drying (*2 seconds*) employed by Applicants in Example 1 of the present specification. As Mack notes at column 5, line 60, heat treatment through roasting is a known method for removing bromine.

Clearly, however, the prior art products achieved Yellow Indexes of 14.8 to 16.1 only *after* they were *roasted* for a period of time 900 times longer than Applicants dried their claimed product.

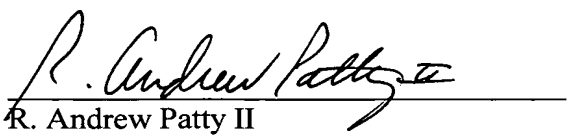
Finally, the Examiner's summary of her own arguments again reveals the fact that she relies upon the Applicants' disclosure to make her case. The last fragmentary paragraph of page 5 of the Answer reads:

> In summary, if the color of the wet cake evidences its occluded free bromine content as disclosed by the present specification (see page 14, section 0048) and Mack teaches several treatment methods for improvement in the color of the brominated product, the skilled artisan would have the reasonable expectation that the prior art wet cake treated as taught by Mack would have low amounts of occluded free bromine content even though the amount is not disclosed by the reference.
>
> (Emphasis added.)

The Examiner not only improperly relying upon Applicants' disclosure in an effort to support her rejection, she also erroneously attributes a low occluded free bromine content to the prior art wet cake on the basis of the disclosed Yellowness Indexes of the prior art end product. Yet, that prior art end product was not only quickly dried at 120°C; it also was heat-treated *for 30 minutes prior* to the determination of the Yellowness Indexes. Such an apples-to-oranges comparison does not represent a reasonable interpretation of the prior art reference from the perspective of one of ordinary skill in the art.

In view of all the foregoing, Applicants respectfully suggest that the Examiner has failed to establish a *prima facie* case of obviousness in view of Mack, and all of the present claims should be allowed. A reversal of the Examiner is solicited.

Respectfully submitted,



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